

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

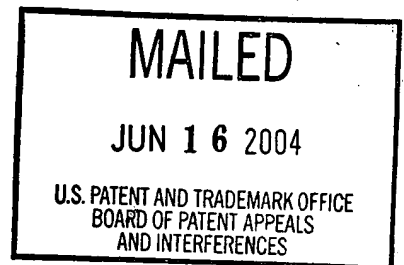
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACQUES BELISSENT,
FRED BATTY, TIMOTHY MISNER,
DARYL HUFF and
ANIL SRIVASTAVA

Appeal No. 2003-0334
Application 09/519,964

ON BRIEF



Before JERRY SMITH, KRASS, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-19, which constitute all the claims in the application.

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The disclosed invention pertains to a method and apparatus for identifying, in a directory server, a new mail domain associated with an incoming message that is received by a messaging server.

Representative claim 1 is reproduced as follows:

1. A method of identifying, in a directory server, a new mail domain associated with an incoming message that is received by a messaging server, comprising:

receiving a new domain name associated with the incoming message at the messaging server;

creating a corresponding entry in a directory in the directory server for every component included in the new domain name that does not already exist in the directory;

automatically updating a corresponding real domain service record in a domain name server associated with the directory server based upon the entry; and

identifying the new mail domain by the directory server based upon the automatically updated real domain record.

The examiner relies on the following references:

Masters et al. (Masters)	5,920,697	July 06, 1999
Call	6,154,738	Nov. 28, 2000
		(filed May 21, 1999)

Claims 1-19 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Masters in view of Call.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-19. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

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determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

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223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

The examiner has indicated how he finds the claimed invention to be obvious over the teachings of Masters and Kim [answer, pages 3-7]. With respect to independent claims 1, 10 and 14, the examiner essentially finds that Masters teaches the claimed invention except that Masters does not explicitly show the process of using the domain name associated with the incoming message at the Messaging server. The examiner cites Call as teaching that the use of a domain name associated with the incoming message at the Messaging server was well known in the art. The examiner finds that it would have been obvious to the artisan to modify Masters in view of Call by including the use of the domain name associated with an incoming message since Call teaches that the use of a domain name was well known in the art.

With respect to independent claim 1, appellants argue that Masters updates a routing table based on e-mail components which are already known to an associated directory service.

Appellants argue that Masters never describes or suggests the need to modify the domain service record in response to changed routing information. Appellants argue that Masters does not teach or suggest a method or apparatus for adding new domains and their associated domain service record as claimed. Appellants argue that even though Call teaches the use of domains and their associated domain service record, Call adds nothing to Masters with respect to adding new domains and associated domain service records. Thus, appellants argue that merely updating routing tables, as taught by Masters and Kim, does not offer any teaching on how to automatically update domain server records to incorporate new domain names [brief, pages 5-6]. Appellants make the same arguments with respect to independent claims 10 and 14.

The examiner responds that Masters teaches that a new routing table is created when new routing information becomes available. The examiner concludes, therefore, that Masters discloses the process of updating the routing table based upon newly received routing information. The examiner admits that Masters does not teach the process of using the domain names associated with the incoming message at the Messaging server, but the examiner notes that Call teaches that domain names associated with incoming messages were well known in the art. The examiner

repeats his position that the claimed invention would have been obvious to the artisan in view of the collective teachings of Masters and Kim [answer, pages 8-10].

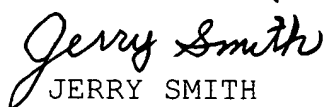
We will not sustain the examiner's rejection of independent claims 1, 10 and 14 for essentially the reasons argued by appellants in the brief. The claimed invention recites that when a new domain name is received, new entries in a directory are created for all components that do not exist in the directory, and a real domain service record in a domain name server associated with the directory server is automatically updated. As argued by appellants, Masters relates to updating routing table information as new information is received. Masters teaches nothing about receiving information related to a new domain name. The fact that domain names per se were well known provides no basis to modify Masters to base the routing table on domain name information. As noted by appellants, the routing in Masters relates to source and destination points which are already known to the system. Masters simply determines the optimum path in which to route the information. There is no suggestion in Masters or Kim of receiving new domain names and then creating entries in a directory and updating a domain

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service record in a domain name server as recited in claims 1, 10 and 14.

Since we do not sustain the examiner's rejection of independent claims 1, 10 and 14, we also do not sustain the examiner's rejection of any of the claims which depend therefrom. Since we have not sustained the examiner's rejection with respect to any of the claims on appeal, the decision of the examiner rejecting claims 1-19 is reversed.

REVERSED



JERRY SMITH)
Administrative Patent Judge)



ERROL A. KRASS)
Administrative Patent Judge)

BOARD OF PATENT
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HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

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